

Applicants: MERON, Gavriel et al.
Serial Number: 10/036,490
Attorney Docket: P-2038-US1

REMARKS

Applicants have carefully studied the Office Action. This paper is intended to be fully responsive to all points of rejection and objection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Status of the Claims

Claims 1-5, 7-11, 14-16, 18-22, 46 and 50 are pending in the Application. Claims 23-44 and 47-48 have previously been withdrawn from consideration, without prejudice or disclaimer. Claims 6, 12, 13, 17, 45 and 49 have previously been canceled, without prejudice or disclaimer.

Applicants respectfully request favorable reconsideration and entry of the requested Amendment to claim 1, and cancellation of claim 2 without prejudice or disclaimer.

Finality of Action

Applicants acknowledge the fact that the outstanding Office Action was made Final and, therefore, the Examiner may not allow entry of substantive amendments to the claims, e.g., amendments that may require further searching, at this point, without accompanying such amendments with a Request for Continued Examination under 37 CFR 1.114.

However, Applicants believe that upon reviewing the above proposed amendments and the following remarks, the Examiner will appreciate that the changes in the claims relate to subject matter already within the scope of the searches and discussions to date, and that entry of these proposed amendments will not require additional searches and will not impose any other burden on the Examiner to justify filing of a Request for Continued Examination.

Applicants respectfully request favorable reconsideration of the application and entry of the proposed amendments. However, if the Examiner believes that a Request for Continued Examination under 37 CFR 1.114 is warranted in this case, the Examiner is hereby requested to kindly respond to this proposed Amendment in a timely issued

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Advisory Action that will present the Applicants with an opportunity to file a Request for Continued Examination or a Notice of Appeal without incurring additional fees to obtain Extensions of Time.

Voluntary Amendment of Claims

Applicants request to amend claim 1 to clarify what the Applicants regard as the invention.

No new matter has been added by the requested amendment.

For purposes of clarity, claim 1 is referred to herein as "amended" claim 1.

Applicants request to cancel claim 2, without prejudice or disclaimer.

Claim Rejections under 35 USC §112, Second Paragraph

The Examiner rejected claim 2 under 35 USC §112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Without conceding the appropriateness of the rejection of claim 2, Applicants request to cancel claim 2, without prejudice or disclaimer.

In view of the above, upon entry of the amendment, the rejection of claim 2 under USC §112, Second Paragraph is moot.

Claim Rejections under 35 USC §103(a)

The Examiner rejected claims 1-5, 7, 8, 14-16, 18-22, 46 and 50 under 35 USC §103(a) as being unpatentable over Kovacs et al., United States Patent Number 5,833,603 ("Kovacs") in view of Desai et al., United States Patent Number 5,362,478 ("Desai"). Applicants respectfully traverse this rejection.

According to M.P.E.P. §2142, "In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

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Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

Without conceding the appropriateness of the combination, Applicants respectfully submit that the combination of Kovacs and Desai does not meet the requirements of an obviousness rejection as applied to claims 1-5, 7, 8, 14-16, 18-22, 46 and 50, in that the combination at least fails to teach or suggest all the elements of these claims.

Amended independent claim 1 recites, *inter alia*, "a battery within said autonomous swallowable capsule to provide power to said detecting unit". Kovacs and/or Desai, alone or in combination, do not disclose, teach or suggest at least this feature of the claimed invention.

Applicants would like to point out that the implantable transponder of Kovacs does not include a battery, but rather includes an energy coupler to receive energy from a remote energy source on a non-continuous basis; whereas the swallowable capsule of Desai does not include, and is not operated by, any type of power source.

Therefore, without conceding the appropriateness of the combination, Kovacs and/or Desai do not render claim 1 obvious.

Claims 2-5, 7, 8, 14-16, 18-22, 46 and 50 are dependent from amended independent claim 1, and include all the features of amended independent claim 1 as well as additional distinguishing features. Therefore, it is respectfully submitted that the patentability of claims 2-5, 7, 8, 14-16, 18-22, 46 and 50 follows directly from the patentability of amended independent claim 1 and therefore.

In view of the above, Applicants respectfully request that the rejection of claims 1-5, 7, 8, 14-16, 18-22, 46 and 50 under 35 USC §103(a) as being unpatentable over Kovacs in view of Desai be withdrawn.

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The Examiner rejected claims 9-11 under 35 USC §103(a) as being unpatentable over Kovacs in view of Atarashi et al., United States Patent Number 6,162,469 ("Atarashi"). Applicants respectfully traverse this rejection.

Without conceding the appropriateness of the combination, Applicants respectfully submit that the combination of Kovacs and Atarashi does not meet the requirements of an obviousness rejection as applied to claims 9-11, in that the combination at least fails to teach or suggest all the elements of these claims.

Claims 9-11 depend from amended independent claim 1, which recites, *inter alia*, "a battery within said autonomous swallowable capsule to provide power to said detecting unit". Kovacs and/or Atarashi, alone or in combination, do not disclose, teach or suggest at least this feature of the claimed invention.

Applicants would like to point out that the implantable transponder of Kovacs does not include a battery, but rather includes an energy coupler to receive energy from a remote energy source on a non-continuous basis; whereas the medical powder of Atarashi does not include, and is not operated by, any type of power source.

Therefore, without conceding the appropriateness of the combination, Kovacs and/or Atarashi do not render claims 9-11 obvious.

In view of the above, Applicants respectfully request that the rejection of claims 9-11 under 35 USC §103(a) as being unpatentable over Kovacs in view of Atarashi be withdrawn.

Conclusion


In view of the foregoing amendment and remarks, and upon entry of the requested amendment, Applicants respectfully submit that claims 1, 3-5, 7-11, 14-16, 18-22, 46 and 50 are deemed to be allowable. Their favorable reconsideration and allowance are respectfully requested.

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Should the Examiner have any question or comment as to the form, content or entry of this paper, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

No fees are believed to be due in connection with this paper. However, if any fees are due, please charge any such fees to deposit account No. 50-3355.

Respectfully submitted,



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